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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,084	03/12/2004	Greg Siwak	10759-00048	8523

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EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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03/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,084	SIWAK ET AL.	
	Examiner	Art Unit	
	Steven Reynolds	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 and 34-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 34-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>English Translation of 'EP 659649'</u> |

DETAILED ACTION

1. This office action is in response to the reply filed on 1/23/2008, wherein claims 32, 35, 37 and 38 were amended; and claim 33 was cancelled. Claims 32 and 34-56 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 32, 34 and 36-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (US 2005/0045521) in view of Castaneda et al. (US 2002/0179482). Johnson discloses a product package capable of holding a product being offered for sale to a purchasing consumer; a non-rigid body containing the product, the body comprising a generally flat base (12) and upstanding side walls (14) defining a generally rectangular, single compartment cavity above the base and

extending between the upstanding side walls; a cover (18) configured to close said cavity, the cover extending in a generally flat and parallel relation to the base when the cover is closed; and a closure member (zipper) fastening said cover to said base, the closure member being movable relative to the cover and to the base between open and closed positions. Johnson discloses the claimed invention except for the specifics of the product.

However, Castaneda teaches a lunch box comprising a removable thermos bottle (26) for the purpose of carrying a beverage in the lunch box. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the lunch box of Johnson with a thermos bottle as taught by Castaneda in order to carry a beverage in the lunch box. The thermos bottle can be considered a product being offered for sale as thermos are often sold separately or in combination with a lunch box.

Regarding claims 34 and 36-41, Johnson-Castaneda discloses the package has the size and shape of a lunchbox; a handle attached to one of the upstanding side walls (See paragraph 3, lines 4-8); said closure member comprises a zipper mechanism securing the cover three of the upstanding side walls; said closure member is located at or near a top edge of the side walls; the cover is integrally formed with one of the side walls, the cover being folded over the base when closed; and the compartment, more specifically the base is expandable to enlarge the single compartment (soft-sided coolers are vertically collapsible); and the body is insulated to maintain the temperature of an item in the compartment.

5. Claims 32 and 34-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrick et al. (EP 659,649) in view of Meyers (US 2,648,412). Claims 32, 35-37, 42, 43, 45, 50, 53 and 54, Petrick discloses a product package comprising a pair of footwear (shoes) to be worn by a person, the footwear being offered for sale at a point of purchase (discloses a packaging container for shoes); a support surface (2 – See Fig. 1) dimensioned to support the footwear; a plurality of non-rigid/soft side walls (flexible material walls 3 – See Fig. 1) extending from said support surface and defining a cavity/compartment to surround the footwear above said support surface, the footwear substantially filling a space between the side walls, and wherein at least one of said side walls comprises a flap (4) folded over the remaining side walls to define a cover over said cavity (See Fig. 1 embodiment). Petrick discloses the claimed invention except for the specifics of the closure member and the handle.

However, Meyers teaches a case comprising a support surface, soft side walls and a cover that is hinged to a side wall, including a zipper (11) for the purpose of securing the cover in its closes position; and a handle (18) attached to a side wall for the purpose of carrying the case. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Petrick with a zipper and handle as taught by Meyers in order to more securely hold the cover closed and to more easily carry the device.

Regarding claims 33 and 46, Petrick-Meyers discloses the upstanding side walls comprise a first pair of generally flat and parallel side walls extending from opposing

side edges of the base, and a second pair of generally flat and parallel side walls interconnecting the first pair of side walls.

Regarding claims 34 and 47, Petrick-Meyers discloses the package has the size and shape of a lunchbox.

Regarding claims 38 and 48, Petrick-Meyers discloses said closure member/zipper is located at or near a top edge of the sidewalls (See Meyers Fig. 1).

Regarding claim 39, Petrick-Meyers discloses the cover is integrally formed with one of the side walls, the cover being folded over the base when closed.

Regarding claims 40, 41, 44 and 51, Petrick-Meyers discloses the base is expandable to enlarge the single compartment (See Petrick Figs. 3 and 5).

Regarding claims 49 and 52, Petrick-Meyers discloses said package is convertible into a duffel bag (Petrick-Meyers discloses the same structure and layout as applicant's invention, therefore the device of Petrick-Meyers is considered a duffel bag).

Regarding claims 55 and 56, Petrick-Meyers discloses the package is insulated to maintain a temperature of an item in the cavity (the package is insulated due to the material properties of the side walls).

Response to Arguments

6. Applicant's arguments filed 1/23/2008 have been fully considered but they are not persuasive. Contrary to applicant's arguments that Petrick does not disclose a non-rigid container as claimed: It is clear from the abstract and drawings, particularly Fig. 5 showing the side walls to be flaccid and non-rigid.

Regarding applicant's argument that the abstract discloses "stable-impact resistant materials": this refers to the frame-like components (5, 8), not the flexible insert shown in Fig 1. The flexible insert as described above is fully capable of being provided with a zipper and handle to more securely hold the cover closed and to more easily carry the device.

Examiner provides a translation of the document for convenience even though it was clear from the abstract and drawings that the material is non-rigid.

From MPEP § 706.02, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mickey Yu/
Supervisory Patent Examiner, Art
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/S. R./
Examiner, Art Unit 3728